

REMARKS

I. Summary of Office Action

Claims 1-86, 89-133, and 135-144 are pending in this application.

The Examiner has requested corrected drawings because of problems detailed in a draftsman's review.

The Examiner has rejected claims 1-86, 91-133, and 142-144 under 35 U.S.C. § 103(a) as being obvious from Brenner et al. U.S. Patent No. 6,004,211 (hereinafter "Brenner") in view of Lappington et al. U.S. Patent No. 5,734,413 (hereinafter "Lappington"). Claims 89, 90, and 135-141 were rejected under 35 U.S.C. § 103(a) as being obvious from Brenner in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue").

II. Summary of Applicants' Reply to Office Action

Applicants wish to thank Examiner Enatsky for his time and courtesy during a telephonic interview on March 10, 2004.

This Reply is accompanied by a Supplemental Information Disclosure Statement. This Reply is also accompanied by a Submission of Formal Drawings.

The Examiner's rejections are respectfully traversed.

III. Request for Corrected Drawings

The Examiner states that "new corrected drawings are required in this application because of problems [detailed] in a draftsperson's review" (Final Office Action, page 2, lines 6 and 7). Applicants are unsure of what the Examiner is referring to, since applicants have not received a draftsperson's review in connection with the drawings. As far as applicants know, the only outstanding issue in connection with the drawings is whether or not the Examiner approves of the amendment to FIG. 5 proposed in the October 28, 2002 Reply to Office Action, and again proposed in the February 26, 2003 Reply to Office Action. Applicants assume that the Examiner's objection to the drawings stems from this outstanding issue. Accordingly, in order to advance prosecution, applicants are submitting concurrently herewith a Submission of Formal Drawings with a replacement drawing sheet for FIG. 5 incorporating our proposed amendment.

IV. Summary of Telephonic Interview

On March 10, 2004, the Examiner, the undersigned, and the undersigned's colleague, Mr. Hong Lin, conducted a telephonic interview on the merits of this application. The undersigned requested clarification of the Examiner's

motivation to combine Brenner with Lappington, as set forth in the Final Office Action. In particular, the undersigned contended that the Examiner did not appear to address applicants' previous motivation arguments, set forth in the September 19, 2003 Reply to Office Action. In response, the Examiner referred the undersigned and Mr. Lin to the Final Office Action, and in particular to the contention made on page 8, lines 16-18 of the Final Office Action. The Examiner stated that if the undersigned and Mr. Lin did not believe that the contention at page 8, lines 16-18 of the Final Office Action addressed applicants' previous motivation arguments, then applicants should reiterate the previous arguments in this response.

V. The Section 103 Rejection of
Claims 1-86 and 91-133

The Examiner rejected claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being obvious from Brenner in view of Lappington. This rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 1, 44, and 91, is directed towards a method, system, and computer readable medium for submitting electronic wagers on races that are to be run to computer equipment over a communications network. At least one wireless portable computing device with a display is in two-way wireless

communications with in-home user equipment. A user at the wireless portable computing device is provided with on-screen options on the display of the wireless portable computing device that allow the user to create a wager. The on-screen options are based, at least in part, on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment. The information is based, at least in part, on racing data received by the in-home user equipment from the communications network. The user is allowed to wirelessly transmit the wager from the wireless portable computing device to the in-home user equipment over the wireless communications path when it is desired to submit the wager for processing.

Applicants respectfully submit that independent claims 1, 44, and 91 are allowable over Brenner in view of Lappington for at least the following reasons.

A. The Combination Of Brenner And The Wireless Handheld Device Of Lappington Does Not Show Or Suggest All Elements Of Applicants' Claims

Contrary to the Examiner's contention, applicants respectfully submit that the combination of Brenner and Lappington would not result in displaying the wagering screens of Brenner on handheld 32 of Lappington to "provide a

user at [a] wireless portable computing device with on-screen options on the display of the wireless portable computing device that allow the user to create a wager for a given race to be run," as required by independent claims 1, 44, and 91. In other words, and as previously submitted by applicants, the trivia game displayed on handheld 32 of Lappington would not be swapped for the wagering interfaces of Brenner if Brenner and Lappington were combined. At best, combination with handheld 32 of Lappington would allow a user to interact with the menus on monitor 126 or monitor 378 of Brenner using the handheld device.

In response, the Examiner contends that "Lappington clearly shows that game information can be displayed on the disclosed handheld" (Final Office Action, page 8, line 2). Applicants submit, however, that the game information displayed on the handheld of Lappington is different from the wagering screens of Brenner. In particular, the game information in Lappington is stripped from the vertical blanking interval of a television signal and is transmitted by a set-top box to handheld device 32 for display. In Brenner, in contrast, the wagering screens are generated by an interactive wagering software application, such that racing data received by the in-home user equipment is

presented to the user in a graphical user interface, complete with graphics and icons. Thus, contrary to the Examiner's contention, the fact that Lappington shows trivia game information on a handheld device still does not result in providing the wagering screens of Brenner on that device if combined.

B. The Examiner Failed To Provide A
Sufficient Motivation For Transferring
The Wagering Interfaces Of Brenner
To Handheld 32 Of Lappington

The Examiner, in an attempt to address applicants' previous arguments regarding the lack of motivation for combining Brenner and Lappington, contends that his "use of Lappington to provide [the] missing features is sufficient to show that Applicants' invention is an obvious modification of Brenner to incorporate existing technology set-top games" (Final Office Action, page 8, lines 16-18). In the telephonic interview conducted on March 10, 2004, the Examiner neither clarified this statement nor was willing to explain how this statement relates to (1) his previous contentions regarding motivation to combine Brenner with Lappington or (2) applicants' previous arguments (see Section IV of this Reply). Applicants respectfully submit that not only has the Examiner failed to address applicants'

previous arguments regarding the lack of motivation to combine Brenner and Lappington, but this statement suggests the Examiner has abandoned his previous motivation arguments in favor of this new motivation for arriving at applicants' invention.

Applicants respectfully submit that this motivation simply relies on applicants' claimed technique "as a blueprint for piecing together the prior art to defeat patentability," and therefore is insufficient as a matter of law. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). In particular, the Examiner merely concludes that applicants' claimed invention is an obvious modification of Brenner by identifying the features of applicants' claimed invention missing from Brenner and "us[ing] Lappington to provide these missing features," without providing any motivation for doing so (Final Office Action, page 8, lines 17 and 18). This approach is not sufficient to establish a prima facie case of obviousness.

Applicants respectfully submit, therefore, that the § 103 rejections should be withdrawn. See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some

teaching, suggestion, or motivation to combine the references"); see also MPEP §§ 2142 and 2143.01.

The above notwithstanding, applicants further maintain their previous arguments regarding the lack of motivation to combine Brenner and Lappington, as set forth in the September 19, 2003 Reply to Office Action. As suggested by the Examiner in the March 10, 2004 telephonic interview, these arguments are reiterated for the Examiner's reference hereinbelow.

1. "Allow[ing] The Race To Be Displayed
On A Separate Display Continuously"
Is Not A Sufficient Motivation

The Examiner contends that "it would have been obvious to one skilled in the art at the time to display informational/wager choices on the PDA to allow the race to be displayed on a separate display continuously" (March 20, 2003 Office Action, page 3, lines 4-6). Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington because a user of the system of Brenner can place a wager while watching racing video at the same time: "[r]acing videos can be viewed while the user reviews odds and places bets" (Brenner, Abstract). Thus, because a user of the system of Brenner can view a race continuously while

making wagering selections, the Examiner's motivation to provide racing video on a separate display is insufficient.

2. "View[ing] Multiple Concurrent Events Without Losing Scores" Is Not A Sufficient Motivation

The Examiner also contends that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp for the purposes taught . . . by Lapp such as view multiple concurrent events without losing scores" (March 20, 2003 Office Action, page 3, lines 6-9). Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington. The "interactive games" of Lappington, which are basically trivia games that a television viewer can play along with while watching a television program, cannot be analogized to the wager creation process of Brenner. In Lappington, "where a viewer returns to a program that was previously watched, the interactive game continues, leaving out only the part [of the interactive game] that was missed" (column 4, lines 1-3). Thus, in Lappington, when a viewer changes channels to watch another program, the viewer misses certain trivia questions, although a total score is maintained by the handheld device.

Analogizing this to the wager creation process of Brenner would result in skipping certain steps in the wager creation process (e.g., selecting a track, selecting a horse, etc), thereby rendering the wager creation process incomplete. Furthermore, there is no analogous "score" to be kept in Brenner. Thus, the purpose of Lappington to "view multiple concurrent events without losing scores," as set forth by the Examiner, has no relevance to Brenner. Accordingly, the motivation provided by the Examiner is insufficient.

3. "Plac[ing] Multiple Concurrent
Bets On Different Races" Is
Not A Sufficient Motivation

The Examiner further contends that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp [to allow] one to place multiple concurrent bets on different races, releasing the constraints of betting only on a single game at any one time.

(March 20, 2003 Office Action, page 3, lines 6-11)

Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington. To modify Brenner to allow for the "concurrent" creation of wagers, it would be reasonable to expect one of skill in the art to modify the software of Brenner that provides the wagering interfaces. It would not be reasonable to expect one of skill in the art to first

modify Brenner by putting the wagering interfaces on a separate device (e.g., handheld 32 of Lappington), and then modify the software to allow for concurrent creation of wagers.

Thus, for at least these reasons, claims 1, 44, and 91 are allowable over Brenner in view of Lappington. Therefore, applicants request that the rejection of claims 1, 44, and 91 based on Brenner in view of Lappington be withdrawn. In addition, claims 2-43, 45-86, and 92-133 are allowable at least because independent claim 1, from which claims 2-43 depend, independent claim 44, from which claims 45-86 depend, and independent claim 91, from which claims 92-133 depend, are allowable. Accordingly, applicants request that the rejection of claims 2-43, 45-86, and 92-133 be withdrawn.

VI. The Section 103 Rejection of
Claims 142-144

The Examiner rejected claims 142-144 under 35 U.S.C. § 103(a) as being obvious from Brenner in view of Lappington and further in view of "well known . . . set-top devices" (Final Office Action, page 6, line 3). The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 142-144, is directed towards a method, system, and

computer readable medium for submitting electronic wagers on races that are to be run to computer equipment over a communications network. At least one wireless portable computing device with a display is in two-way wireless communications with a television set-top box.

Applicants' claims 142-144 are allowable over Brenner in view of Lappington for at least the reasons provided hereinabove in Section V with respect to claims 1, 44, and 91. In particular, the Examiner's reliance on "well known . . . set-top devices" does not overcome the fact that the combination of Brenner with handheld 32 of Lappington would not result in the inclusion of the wagering interfaces of Brenner on handheld 32. Accordingly, applicants request that the rejection of claims 142-144 based on Brenner in view of Lappington and further in view of "well known . . . set-top devices" be withdrawn.

VII. The Section 103 Rejection of
Claims 89, 90, and 135-141*

The Examiner rejected claims 89, 90, and 134-141 under 35 U.S.C. § 103(a) as being obvious from Brenner in view of LaDue. This rejection is respectfully traversed.

* Applicants canceled claim 134 in the February 26, 2003 Reply to Office Action and therefore respectfully submit that the Examiner's inclusion of this claim in the rejection is in error.

Applicants' invention, as defined by claims 89, 90, and 135, is directed towards a method, system, and computer readable medium for wirelessly submitting electronic wagers to computer equipment. The user is allowed to create a wager with wireless user equipment and is allowed to transmit that wager from the wireless user equipment to a communications network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment. The wager is received at the computer equipment for processing from communications equipment at the racetrack over the communications network.

In response to applicants' arguments set forth in the September 19, 2003 Reply to Office Action, the Examiner contends that "there are no gaps in features taught by Brenner in view of LaDue to meet Applicants' claims" (Final Office Action, page 9, lines 6 and 7). In particular, in an attempt to show communications equipment capable of wireless communication in Brenner, the Examiner states that Brenner "teaches information delivery can be accomplished through broadcast or satellite systems" (Final Office Action, page 22 to page 9, line 1). Applicants respectfully submit, however, that the Examiner has still failed to show communications

equipment at a racetrack for communicating wirelessly with wireless user equipment.

Furthermore, applicants submit that the Examiner has not provided a suitable motivation for combining Brenner and LaDue. It appears that the Examiner still contends that integrating wireless wagering "into existing wireless networks without requiring additional network build-outs" (Final Office Action, page 9, lines 3 and 4) is a valid motivation to combine Brenner with LaDue. This is not so. In particular, because neither Brenner nor LaDue shows communications equipment at a racetrack as defined by applicants' claims, at least some network build-out would be required to install the communications equipment at the racetrack.

Thus, for at least these reasons, claims 89, 90, and 135 are allowable over Brenner in view of LaDue. Therefore, applicants request that the rejection of claims 89, 90, and 135 based on Brenner in view of LaDue be withdrawn. In addition, claims 136-141 are allowable at least because independent claim 89, from which claims 138 and 139 depend, independent claim 90, from which claims 140 and 141 depend, and independent claim 135, from which claims 136 and 137 depend, are allowable. Accordingly,

applicants request that the rejection of claims 136-141 be withdrawn.

VIII. Conclusion

In view of the foregoing, applicants respectfully submit that claims 1-86, 89-133, and 135-144 are patentable. This application is therefore in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of this application.

Respectfully submitted,

A handwritten signature in cursive script, reading "Laura A. Sheridan", written over a horizontal line.

Laura A. Sheridan
Registration No. 48,446
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090